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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,879	11/03/2003	James W. Wieder	W03-003	2878

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EXAMINER
OSBORNE, MATTHEW C

ART UNIT	PAPER NUMBER
3694	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/605,879	WIEDER, JAMES W.	
	Examiner	Art Unit	
	Matthew Osborne	3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *41-60* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *41-60* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *03 November 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :20040109, 20041223, 20051121, 20060110.

DETAILED ACTION

This is the first office action on the merits for Application 10/605879.

Claims 41-60 have been examined.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 41-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "high priority" in claim 41 is a relative term which renders the claim indefinite. The term "high priority" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of examination only, the language is omitted.

3. Claim 51 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "high priority" in claim 51 is a relative term which renders the claim indefinite. The term "high priority" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of examination only, the language is omitted.

4. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. The term "minimal actions by the user" in claim 59 is a relative term which renders the claim indefinite. The term "minimal actions by the user" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. For the purposes of examination only, the language is omitted.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 41-43, 48, 49-52, and 56 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen ("iTunes 3.0.1 released." Macworld. Sep 18, 2002) and Fanning ("Review: iTunes 3.0.1." Macworld. Apr 1, 2003.).

7. Re claims 41-43, 48, 49-52, and 56 Cohen and Fanning disclose the iTunes 3.0.1 software program, which comprises:

- [41, 49] responding to user control actions to affect said sequence (see at least Fanning, "Play Count", and "Last Played" records)
- generating indicators of user preference for a composition, by utilizing user control actions that have affected said sequence (see at least Fanning, "Play Count" and "Last Played" records)

- utilizing said indicators to influence the selection of a composition for playback in said sequence, when there are no current user control actions available to affect said sequence (see at least Fanning, "Smart Playlists")
- whereby said sequence of entertainment compositions/selection of a composition automatically adapts to user preferences implied by control actions. (see at least Fanning, "Smart Playlists")
- [51] modifying said entertainment sequence when requested by new user control actions. (see at least Fanning, "Play Count", and "Last Played" records as they affect "Smart Playlists")
- [42, 50] wherein said user control actions include user actions to replay or go-back to a previous composition, or user actions to skip or forward-past the rest of a currently playing composition, or user actions to select a particular composition to be played. (Replay/go-back/select: see at least Fanning, "Play Count")
- [43, 52] wherein said selection of a composition for playback is also influenced by when the composition was last played or by determining a preferred time between playbacks for the composition. (Last Played: see at least Fanning, "Last Played")
- [48, 56] wherein said influencing utilizes the user usage-rights for a composition or the availability of a composition at the current user device. (Availability: see at least Fanning, inherent in playback of "Smart Playlist")

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 44-46 and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen and Fanning as applied to claims 41 and 49 above, and further in view of Official Notice.

10. Cohen and Fanning do not specifically disclose generating and utilizing being consolidated across a plurality of user devices that may be used at different times and locations where selection is customized for the specific user at the current user device, where the indicators are automatically consolidated and distributed across a network to any location or device the user may currently be at, or where generating and utilizing are associated with each specific user. However, the Examiner takes Official Notice that it was well known at the time of invention to one of ordinary skill that iTunes coupled with an iPod or other networked computers generated, consolidated and distributed musical compositions, playlists (including "Smart Playlists") and user usage data (such as "Ratings") to tailor Smart Playlists to the user at any device on the media network, and that customization and tracking information was recorded individually by each user's own iTunes Library.

11. Claims 47 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen and Fanning as applied to claims 41 and 49 above, and further in view of Jacobi et al. (6317722).

12. Cohen and Fanning disclose all of the limitations of parent claims 41 and 49, *supra*. Cohen and Fanning do not specifically disclose selecting a composition that is probably unfamiliar to the user by utilizing an aggregate correlation of said indicators from many other users. However, Jacobi discloses a method of recommending products or other items to a user "predicted to be of interest to the user" using a process which "analyzes user purchase histories to identify correlations between item purchases" (see at least Abstract). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the recommendation system of Jacobi into the software of Cohen and Fanning in order to create a "legal, profitable approach to distributing music on the Internet" (see at least "Apple's plan to offer music hits right note." Lincoln Journal Star. May 21, 2003; pg 07).

13. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Los Angeles Times ("Week in Review." Los Angles Times. May 4, 2003; pg C2) in view of Jacobi et al. ('722).

14. Re Claims 57, 59, and 60, Los Angeles Times discloses the iTunes Music Store, which comprises:

- [57] playing an unknown composition or a sample sound segment representing a compelling portion of said unknown composition (see at least Abstract, "free 30-second samples")

- adding the composition or the composition's identifier to said user's collection when indicated by a user action occurring while said composition or composition sample is playing (see at least Abstract, "purchases with a click of the mouse")
- whereby said user's collection is expanded. (see at least Abstract, "purchases with a click of the mouse")
- [59] adding to the user's collection the usage-rights for said composition. (see at least Abstract)
- [60] wherein the user's usage- rights are stored and are accessible across a network by any user device the user is currently using. (see at least Abstract)

Los Angeles Times does not specifically disclose generating a customized sequence of compositions for a user, selecting a composition that is probably unknown based upon other compositions already in the user's collection, or selecting influenced by correlating the aggregate control actions of many other users. However, Jacobi discloses a method of recommending products or other items to a user "predicted to be of interest to the user" using a process which "analyzes user purchase histories to identify correlations between item purchases" (see at least Abstract) and generates a sequence of those recommendations for the user (see at least Figure 6). It would therefore be obvious to one of ordinary skill in the art at the time of invention to incorporate the recommendation features of Jacobi into the music store of Los Angeles Times in order to both increase revenues through sales and to broaden the musical exposure of the users.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Osborne whose telephone number is 571-272-7325. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew Osborne
Examiner
AU 3694

/MO/

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